

REMARKS

The present application has been reviewed in light of the Final Office Action mailed June 17, 2010. In view of the arguments presented herein, Applicant requests reconsideration and allowance of the pending claims as presently presented.

Claim Rejections under 35 U.S.C. §102(b)

Claims 1-5 and 7 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,045,560 to McKean et al. (hereinafter McKean). Applicant traverses this rejection for at least the following reasons.

The Examiner does not consider each and every element of the claim. According to MPEP §2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

McKean teaches a surgical stapler wherein fabric bolster material is placed between the staple and patient tissue such that, upon actuation of the stapler, the fabric bolster is stapled to tissue as a reinforcement. The Examiner asserts that the surgical fabric of McKean, *when stapled to a patient using the staple*, anticipates a “capillary fixed to an external surface of at least one of the base leg or support leg having a reservoir defined therein for retaining a liquid” as required by Applicant’s independent claims 1 and 2.

Applicant contends that equating the fabric to a rupturable capillary fixed to a staple is inappropriate. The fabric bolster material is separate from the staple and not a

capillary fixed thereto. McKean fails to disclose each and every element of claims 1 and 2 which require a “capillary fixed to an external surface of at least one of the base leg or support leg”.

In the Final Office Action, page 2, paragraph 3, the Examiner states the following to support a finding of anticipation:

“In reference to claims 1-5 and 7, McKean et al. discloses a surgical fastener system comprising: a fastener including a base leg and a support leg, the base leg being selectively deformable and including at least one traumatic tip for piercing tissue, and at least one capillary 140 having a reservoir (cellulose material) therein for retaining a liquid (column 4 lines 13-30, line 67- column 5 line 4) such that the capillary is rupturable (penetrated by tip) with the deformation of the surgical fastener; a loading unit 135; and an actuator 132.”

Claim 1 requires a “capillary fixed to an external surface of at least one of the base leg or support leg”. *Emphasis added.* In the above-cited passage, the Examiner fails to consider this important limitation. It is clear that the staple in McKean passes through the bolster material and the bolster material is not affixed thereto. As such, the Examiner has not shown that each and every element as set forth in Applicant’s claims 1 and 2 are found in McKean. Therefore, the requirements of MPEP §2131 for a finding of anticipation are clearly not met. For at least this reason, the rejections of claims 1-5 and 7 are not supported by the Final Office Action. Since each and every element of Applicant’s claims 1-5 and 7 are not found in McKean, the rejection under 35 U.S.C. §102(b) must be withdrawn.

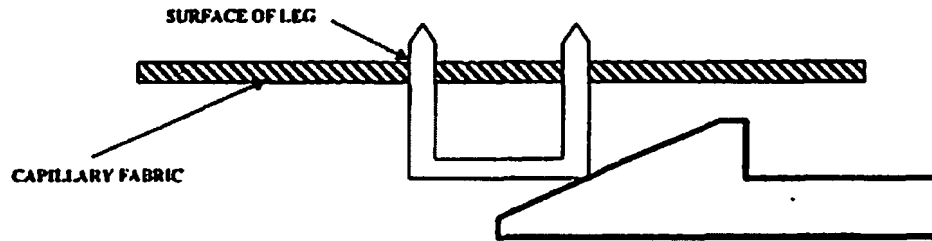
On page 4, paragraph 6 of the Final Office Action, the Examiner takes the strained position that “as the fastener of McKean is pushed from the cartridge, the fastener will penetrate a fabric, which is porous (thereby defining a capillary structure),

such that the fabric is fixed to an external surface of a leg of the fastener.” How this can possibly anticipate Applicant’s invention is unknown and Applicant refutes this logic for at least the following reasons.

On page 4 of the Final Office Action, the Examiner presents a drawing (reproduced below) that allegedly depicts the McKean device. Applicant respectfully notes this drawing is not part of the McKean reference. It is instead made by the Examiner to explain the examiner’s own unreasonable interpretation of the McKean subject matter. Applicant objects to this improper use of fabricated evidence.

Applicant’s independent claims 1 and 2 further require “said at least one capillary being rupturable simultaneously with the deformation of said surgical fastener”.

Emphasis added. As shown by the Examiner’s own sketch, the staple ruptures the fabric at a point in time prior to the deformation of the staple, not “simultaneously with the deformation of said surgical fastener” as required by Applicant’s claims. An instantaneous event such as a rupture cannot occur both prior to and simultaneously with some other event. Therefore, the untenable scenario devised by the Examiner cannot possibly meet the limitation recited in Applicant’s independent claims requiring “one capillary fixed to an external surface of at least one of the base leg or support leg having a reservoir defined therein for retaining a liquid, each of said at least one capillary being rupturable simultaneously with the deformation of said surgical fastener to dispense said liquid simultaneously upon being ruptured.” Therefore, and again, McKean cannot properly be used as an anticipatory reference under 35 U.S.C. §102(b) and the rejection of Applicant’s claims thereunder should be withdrawn.



Examiner's sketch of the McKean staple, Office Action, page 4.

Applicants submit that the Examiner's construction renders Applicant's invention unsuitable for its intended purpose.

McKean's fabric is not suitable for Applicant's intended purpose, to wit, to "dispense said liquid simultaneously upon being ruptured." In the Final Office Action, the Examiner states:

Applicant has argued that McKean et al. fails to disclose a fastener having a "capillary fixed to an external surface of at least one of the base leg or support leg". As illustrated below, as the fastener of McKean is pushed from the cartridge, the fastener will penetrate a fabric, which is porous (thereby defining a capillary structure), such that the fabric is fixed to an external surface of a leg of the fastener.

The Examiner's scenario requires the capillary fabric to be ruptured in order for the capillary fabric to be fixed to an external surface of a leg of the fastener. However, as recited in Applicant's claims and as discussed in Applicant's specification, Applicant's claims require "the at least one capillary fixed to an external surface of at least one of the base leg or support leg having a reservoir defined therein for retaining a liquid, each of said at least one capillary being rupturable simultaneously with the deformation of said surgical fastener to dispense said liquid simultaneously upon being ruptured." In other

words, the Examiner's construction would require the capillary to be ruptured *before* the staple is deformed, which would negate the utility of Applicant's anastomotic staple.

The Examiner's construction requires the capillary to be ruptured before it is fixed to the staple, since, according to the Examiner's colorful scenario, the fastener has to penetrate the fabric in order for it to be fixed to an external surface of a leg of the fastener. This interpretation is logically inconsistent with Applicant's claim recitation of "at least one capillary fixed to an external surface of at least one of the base leg or support leg having a reservoir defined therein for retaining a liquid, each of said at least one capillary being rupturable simultaneously with the deformation of said surgical fastener." The Examiner's interpretation would incorrectly require the capillary to be ruptured so that it may be fixed to the fastener, which is outside the scope of Applicant's claims which requires the capillary be "fixed" and "rupturable simultaneously with the deformation".

The McKean fabric does not constitute a capillary. The fabric of McKean can be woven, knit, or non woven (col. 4, ll 13-14), but this in no way discloses or implies a capillary. The Examiner asserts that a fabric may be porous (Final Office Action page 4, para. 6). A porous fabric does not include a capillary. According to MPEP §2131, each and every element as set forth in the claim must either expressly or inherently described in a single prior art reference in order to show anticipation. The Examiner's rationale in the Final Office Action fails this test. There is no express description of a capillary in McKean. There is no inherent description of a capillary in McKean, since the mere fact a fabric may be porous, woven, non-woven, or knit does not inherently describe the presence of any capillary structure therein.

According to MPEP §2111, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” For all the reasons presented hereinabove, the Examiner’s interpretation of Applicant’s claims is neither reasonable nor consistent with the specification. MPEP §2111 further states that “the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.” Applicant respectfully submits that one skilled in the art after reading the present application would not interpret Applicant’s claims in the manner purported by the Examiner.

Applicant has earnestly demonstrated that McKean does not disclose each and every element as set forth in Applicant’s claims, and is therefore not an anticipatory reference under 35 U.S.C. §102(b). Accordingly, Applicant submits that claims 1-5 and 7 as previously presented are in condition for allowance, and that the rejection thereof under 35 U.S.C. §102(b) be withdrawn.

Claim Rejections under 35 U.S.C. §103(a)

Claims 6 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKean in view of U.S. Patent No. 6,045,560 to Trumbull et al. Applicant respectfully traverses this rejection for at least the following reasons.

Claims 6 and 8 depend from independent claims 1 and 2. MPEP §2143.03 states that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. Since claims 1 and 2 as currently amended are patentable, claims 6 and 8 which depend therefrom are also patentable. Accordingly, Applicant respectfully requests the rejection of claims 6 and 8 be withdrawn.

CONCLUSION

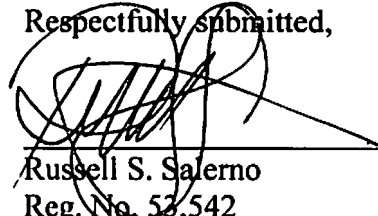
In light of the foregoing arguments, Applicant respectfully submits that independent claims 1-2 and dependent claims 3-8 as currently presented are patentable over the cited references and the other references of record. Favorable consideration of this application is earnestly requested.

Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, she is respectfully requested to contact Applicant's attorney at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

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Respectfully submitted,



Russell S. Salerno
Reg. No. 53,542
Attorney for Applicant

Correspondence address:
COVIDIEN
60 Middletown Avenue
North Haven, CT 06473
203-492-2000

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 420
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526